



7/02 Reconsideration
Lewis, L
11-10-02 Patents

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Norton et al.

Application No. 09/552,073

Filed: April 19, 2000

For: CASH CARD

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GROUP 3600

Art Unit: 3624

Examiner: Geoffrey R. Akers

RESPONSE TO FIRST OFFICE ACTION AND RECORD OF INTERVIEW

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed June 25, 2002, please reconsider the rejection in view of certain comments during a telephone interview and the following remarks.

RECORD OF INTERVIEW

In response to the Official Action, the undersigned contacted Examiner Akers by telephone on October 22, 2002 to discuss the rejection. The Applicant and the undersigned appreciate the courtesy extended by the Examiner during the interview.

Pursuant to 37 C.F.R. § 1.133(b), the following description is submitted as a complete written statement of the reasons presented at the interview as warranting favorable action. The following statement is intended to comply with the requirements of MPEP § 713.04 and expressly sets forth: (A) a brief description of the nature any exhibit shown or any demonstration conducted; (B) identification of the claims discussed; (C) identification of specific prior art discussed; (D) identification of the principal proposed amendments of a substantive

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John R. Harris - Reg. No. 30,388

nature discussed; (E) the general thrust of the principal arguments; and (F) a general indication of any other pertinent matters; and (G) the general results or outcome of the interview, if appropriate.

The undersigned contacted the Examiner to inquire how the Examiner was applying the *Downing* patent and the *Pollin* patent in rejecting the claims. (A) No exhibits were shown or discussed. (B) The independent Claims 1, 10, 13, and 19 were discussed in general, but not specifically. (C) The *Downing* and *Pollin* patents were discussed generally, but not specifically. (D) No proposed amendments were presented or discussed. (E) The general thrust of the discussion was as set forth below in the next paragraphs. (F) No other matters were discussed. (G) No agreement was reached during the interview regarding the claims.

The general thrust of the discussion was the undersigned's brief explanation of certain aspects of the invention. In particular, the undersigned pointed out that the invention, for example as recited in Claim 1, relates to a method for issuing a negotiable instrument, particularly useful for members of the "cash based society" who are often reluctant to enter into a typical relationship with banks. Many members of this group of people often use so-called "Licensed Money Transmitters" such as the WESTERN UNION[®] network to transfer funds to different entities and people, e.g. pay bills and send money to relatives. (See specification, p. 4, lines 13-22.) A particular problem is the inability of such persons to utilize direct deposit of funds, such as federal benefit checks, into systems of Licensed Money Transmitters: "[D]irect deposit of federal benefits checks may only be made into traditional FDIC insured bank accounts." (Specification, p. 5, line 27.)

The invention of Claims 1, 10, and 13 involves use of a first account maintained by a first entity (for example, an FDIC insured bank) and a second account maintained by a second entity (for example, a Licensed Money Transmitter such as WESTERN UNION[®]). Upon a direct deposit into the first account, funds are swept into the second account and treated as a prepaid negotiable instrument, and thereby made available for access from the second account, for example through the funds transfer network of WESTERN UNION[®].

As a specific example discussed with the Examiner, assume that an individual wishes to disburse funds from a federal benefits check via direct deposit in the amount of \$500. The individual instructs the first entity to receive a direct deposit in their name, for use in connection with the invention. Upon a direct deposit into the first account, the \$500 is swept into

the second account, and is thereafter available for access. The individual can then instruct the second entity (e.g. a WESTERN UNION® agent) to generate a negotiable instrument such as a money order for \$200 to a person in another location and generate another instrument for \$100 to pay a bill. The second entity verifies that sufficient funds exist in the second account to issue these negotiable instruments as well as cover the entity's fees for issuing the instruments (say, \$15.00 for each), for a total required amount of \$330.00. The second entity then issues the requested negotiable instruments, leaving an available balance of \$170.00 in the second account.

Beyond a discussion generally along the lines of the foregoing, and directing the Examiner to language in the claims relating to the first account, second account, issuance of negotiable instruments, etc., there was no further discussion of the references or about the claims. The Examiner requested that the undersigned respond to the Office Action in writing along the lines of the foregoing.

In the event that the foregoing record is not considered complete and accurate, the Examiner is respectfully requested to bring any incompleteness or inaccuracy to the attention of the undersigned.

REMARKS

The Applicant and the undersigned attorney thank the Examiner for reconsideration of this patent application. Further consideration of the present application is respectfully requested in light of the following.

Claims 1–21 are pending in the present application. Of these claims, Claims 1, 10, 13, and 19 are independent.

Claims 1–21 were rejected under 35 U.S.C. § 103(a) as unpatentable over the *Downing* patent in view of the *Pollin* patent.

As to Claim 1, the examiner asserted that *Downing* teaches a method of issuing a negotiable instrument to an individual comprising detecting a direct deposit of funds into a first account of an individual and maintained by a first entity and transferring the funds into a second account (citing the Abstract and FIG. 5A). The examiner acknowledged that *Downing* fails to teach detecting a request by an individual for the issuance of a requested negotiable instrument having a value. However, the examiner asserted that *Pollin* teaches this (citing Abstract and col. 5 lines 4–35), as well as determining that the value of the requested negotiable instrument is not